

Application No. 10/804,495

REMARKS

Claims 21-32 and 45 are pending in the application with claim 27 amended herein and new claim 45 added herein.

Claims 27-32 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Without admitting to the propriety of the rejection, Applicant herein amends claim 27 as requested. Applicant requests withdrawal of the indefiniteness rejection.

Claims 27-32 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hays ('477). Applicant requests reconsideration.

Amended claim 27 sets forth a method of forming a phase change ink that includes, among other features, reacting one or more alcohols with one or more monomeric isocyanates and producing a non-polymeric urethane resin from the reacting. The alcohols contain fused-ring alcohols that include at least three fused rings. The method involves including the resin in a phase change ink composition. Pages 2-3 of the Office Action allege that Hays discloses each and every limitation of claim 27. Applicant traverses.

Page 3 of the Office Action alleges that the Hays method yields an isocyanate terminated oligomer and, upon reaction of this oligomer with hydroabietyl alcohol, a non-polymeric urethane resin results. Amended claim 27 now sets forth reacting the alcohols with monomeric isocyanates and producing the non-polymeric urethane resin. Applicant asserts that Hays does not disclose (nor suggest) reacting monomeric isocyanates with alcohols, as claimed.

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At least page 10, lines 11-27 of the present specification provides a list of isocyanates that includes numerous monomeric isocyanates, which may be contrasted with the list of a few dimers, trimers, and oligomers in lines 28-31. One specific monomeric isocyanate includes isophorone diisocyanate now set forth in new claim 45, as supported at least by page 6, lines 9-25 and Examples 1-4 and 13-16 of the present specification. Accordingly, Hayes fails to disclose each and every limitation of claim 27. Claims 28-30 and 45 depend from claim 27 and are patentable at least for such reason as well as for the additional limitations of such claims not disclosed. Applicant requests allowance of claims 27-30 and 45 in the next Office Action.


Claims 21-32 stand provisionally rejected for obviousness-type double patenting over claims of patent applications listed on page 4 of the Office Action. Applicant asserts that all pending claims are otherwise allowable and requests withdrawal of the provisional double patenting rejection.

Claims 21-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13 and 14 of U.S. Patent 7,211,131. Applicant herewith submits a terminal disclaimer overcoming the obviousness-type double patenting rejection.

Applicant herein establishes adequate reasons supporting patentability and requests allowance of all pending claims in the next Office Action.

Respectfully submitted,

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